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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,814	08/22/2001	David Wallach	WALLACH=16B	7986

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EXAMINER

YAEN, CHRISTOPHER H

ART UNIT PAPER NUMBER

1642

DATE MAILED: 02/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/933,814

Applicant(s)

WALLACH ET AL.

Examiner

Christopher H Yaen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9,10 and 20-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9,10 and 20-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed 11/03/2003 is acknowledged and entered into the record. Accordingly, claims 1-8, and 11-19 are canceled, claims 21-23 are newly added.
2. Claims 9-10 and 20-23 are pending and examined on the merits.

Claim Rejections Maintained - 35 USC § 112, 1st paragraph

3. The rejection of claims 9-10, 20 and now newly added claims 21-23 under 35 USC 112, 1st paragraph for lacking written description is maintained for the reasons of record. Applicant argues that the present application is a continuation of an earlier filed application of which a notice of allowance was mailed for claims drawn to "analogs" and "fragments" of SEQ ID No: 2, wherein the claim language is identical to that of the instant application. Applicant further argues that the "analogs" are defined by those that differ from the disclosed sequence of SEQ ID No: 2 by a single amino acid, and "fragments" are characterized as those that bind to the intracellular domain of the FAS ligand receptor (FAS-IC). Applicant further argues that an interview with prior examiners supports concluded that support for analogs was found in the specification. Applicant's arguments have been carefully considered but are not found persuasive. It is noted that the notice of allowance for USSN 08/860,082 has been withdrawn in paper mailed 7/20/2001 and has been suspended due to possible interference with another application. Therefore, claim limitations of analogs and fragments that are identical to those of the prior US application (08/860,082) are immaterial to the allowability of the instant claims. Further, the specification defines analogs as those sequences which

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differ from the native full length sequence of SEQ ID No: 2 by a single amino acid (page 27, line 9), and fragments as those which retain the ability to bind to the FAS-IC (page 28, line 6). The specification and the claims fail to disclose which common structural features are present in the "analogs" of SEQ ID No: 2 so as to allow the skilled artisan to correlate structure and function of the claimed genus. Furthermore, the specification and claims fail to provide a clear indication of which structural features or common attributes are present within "fragments" of SEQ ID No: 2 so as to be entitled to the broad genus of any and all fragment of SEQ ID No: 2 that are capable of binding FAS-IC. Therefore, because the genus is broad, and a representative number of sequences of variants and fragments have not been taught in the specification, the written description is lacking for a method of identifying peptides that are capable of binding to MORT-1.

Conclusion

4. No claim is allowed.
5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

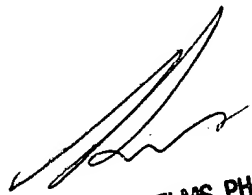
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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher H Yaen whose telephone number is 571-272-0838. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher Yaen
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February 1, 2004



LARRY R. HELMS, PH.D
PRIMARY EXAMINER